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Washington, DC 20037

EXAMINER

GOTTSCHALK, MARTIN A

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3694

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/864,261

Applicant(s)

HAZUMI, MICHIMIRO

Examiner

Martin A. Gottschalk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4-11, 13-22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 9, 11, 13, 15, 17, 19-21, 24, and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 8, 10, 14, 16, 18, 22, 25, 26, and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. Claims 2, 8, 10, 14, 16, 18, 22, 25, 26, and 28-30 have been examined. Claims 2, 8, 10, 14, 16, 18, 22, 25, 26, and 28 are currently amended. Claims 29 and 30 are new. Claims 4-7, 9, 11, 13, 15, 17, 19-21, 24, and 27 are withdrawn. Claims 1, 3, 12, and 23 are cancelled.

Election/Restrictions

2. Applicant's election without traverse of claims 2, 8, 10, 14, 16, 18, 22, 25, 26, and 28 in the reply filed on 09/25/2006 is acknowledged.

3. This application contains claims 4-7, 9, 11, 13, 15, 17, 19-21, 24, and 27 drawn to an invention nonelected without traverse in the reply filed on 09/25/2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

4. The objection to the specification is hereby withdrawn due to Applicant's amendment of the abstract.

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2, 8, 10, 14, 16, 22, 25, 26 and 30 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ross et al (US Pat# 5,823,948, hereinafter Ross).

A. As per claim 2, Ross discloses an electronic medical record information management system (Ross: col 4, lns 52-53), comprising:

at least one electronic medical record information managing means;

a plurality of electronic medical record showing means;

and

a communication network that connects the at least one of said electronic medical record information managing means to said plurality of electronic medical record showing means (Ross: Fig. 1), wherein:

each of

said plurality of electronic medical record showing means, comprises:

a first communication unit for connecting to said communication network
(Ross: Fig. 1, in particular the lines connecting items 7 and 9);

and

at least one first electronic medical record terminal (Ross: Fig. 1, items 9
and 10) that

makes electronic medical records of patients and transmits said
electronic medical records to said electronic medical record
information managing means through said first communication unit
and said communication network (Ross: col 5, lns 53 – 60),

and

makes a request of a user to transmit one or more of said electronic
medical records stored in said electronic medical record information
managing means, and transmits said request to said electronic

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medical record information managing means through said first communication unit (Ross: col 7, lns 5 – 16, Fig. 2, items 102-103),

and

shows one or more of said electronic medical records transmitted from said electronic medical record information managing means to said user (Ross: col 5, lns 56 – 60),

and

said electronic medical record information managing means, comprises:

a second communication unit for connecting to said communication network (Ross: item 8 in particular, note that it connects items 3 and 7);

an electronic medical record storer that stores said electronic medical records of said patients that were transmitted from said electronic medical record showing means (Ross: col 5, ln 66 to col 6, ln 3);

and

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a control server (Ross: col 5, lns 22-24; Fig. 1, item 2, reads on Master Server) that obtains one or more of said electronic medical records stored in said electronic medical record, storer and transmits the obtained one or more of said electronic medical records to said electronic medical record showing means through said second communication unit (Ross: col 4, lns 52-59; col 6, lns 3-10),

wherein:

said at least one first electronic medical record terminal further includes means for adding information to each of said electronic medical records and transmits said electronic medical records and means for transmitting said electronic medical records having the added information to said electronic medical record information managing means through said first communication unit,

and

said control server further makes said electronic medical record storer store said electronic medical records received from said electronic medical record showing means through said second communication unit (Ross: col 5, ln 66 to col 6, ln 3),

and

said control server judges whether said user who transmitted said request is a user who has a second access right or not, and when said user has said second access right, said control server makes said electronic medical record storer store said electronic medical records (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module", note the variety of methods described by which personnel can demonstrate their identity. Note further the restrictions on types of information different types of personnel are allowed to store on the system, for example, physicians can write prescriptions, but clerks can only enter demographic information. In this example, the Examiner considers that the physician has a second access right with respect to the clerk).

B. As per claims 8, Ross discloses an electronic medical record information management system in accordance with claim 2, wherein:

said control server judges whether said user who transmitted said request is a user who has a first access right or not, and when said user has said first access right, said control server obtains said electronic medical record of said patient designated by said request from said electronic medical record storing server

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(Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module"; col 3, Ins 33 - 43).

C. As per claims 10, Ross discloses an electronic medical record information management system in accordance with claim 8, wherein: said electronic medical record showing means, further comprising:

a first access right information making unit that transmits first access right information with which said control server judges whether said user has said first access right or not to said electronic medical record information managing means through said first communication unit, wherein: said control server judges whether said user who transmitted said request is said user who has said first access right or not, based on said first access right information received from said electronic medical record showing means through said second communication unit (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module").

D. As per claim 16, Ross discloses an electronic medical record information management system in accordance with claim 2, wherein:

said electronic medical record includes original data before new data are added (Ross: col 7, Ins 18 - 31. The Examiner considers the existence of an "Historical

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medical record" to indicate the presence of original data prior to the addition of data from "new visits").

E. As per claims 22, 25, and 26 they are method claims which repeat the same limitations of claims 2 and 16, the corresponding system claims, as a series of process steps as opposed to a collection of elements and are thus rejected for the same reasons as the system claims.

F. As per claim 30, it is rejected as per the adding means step of claim 2 above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 18, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross as applied to claim 2 above, and further in view of Wallace et al (US Pat# 6,564,121, hereinafter Wallace).

A. As per claims 18 and 29, Ross fails to explicitly disclose an electronic medical record information management system in accordance with claim 2, wherein:

when data are transmitted between said electronic medical record information managing means and said electronic medical record showing means,

said data are encrypted and said encrypted data are transmitted, and when data are received at said electronic medical record information managing means and said electronic medical record showing means, said data are decrypted.

However, these features are well in the art as evidenced by the teachings of Wallace.

Wallace teaches dispensing medical products over a networked communications system (Wallace: Abstract), with patient medical data that is encrypted locally and decrypted at a remote location (Wallace: col 16, Ins 22-32; Fig. 9B, items 522 and 508).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the use of data encryption/decryption taught by Wallace into the system of Ross with the motivation of better preserving the confidentiality of patient information as it is transmitted over a network (Wallace: col 2, lns 30-35).

B. As per claim 28 it is a method claim which repeats the same limitations of claim 18, the corresponding system claim, as a series of process steps as opposed to a collection of elements. Since the collective teachings of Ross and Wallace disclose the structural elements that constitute the system of claim 18, it is respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claim 28 are rejected for the same reasons given above for claim 18.

The motivation for incorporating the features of Ross and Wallace is as given above in the rejection of claim 18, and is incorporated herein.

Response to Arguments

10. Applicant's arguments filed 06/14/2006 have been fully considered but they are not persuasive.

A. On page 27 of the response, Applicant appears to argue that the Ross reference fails to teach determine a user has access rights to a system after a request for a patient record has been made. In response, the Examiner notes that the claim does not

explicitly recite this feature, and that the "control server" of Ross makes the access determination concerning a user who transmits a request. See also US Pat# 6,339,423 (Sampson et al), claims 1 and 2 for this feature.

B. On page 30, Applicant argues there is no motivation to combine the Ross and Wallace references. The Examiner respectfully disagrees, and directs Applicant to the motivation provided in the Office Action. Note further that one skilled in the computer security arts would be concerned with the teachings of Ross and Wallace as they pertain to this area.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied reference pertains to transmission of computer security access information in conjunction with a request for access to information.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MG
05/22/2007



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PRIMARY EXAMINER